

REMARKS

Claims 1-5, 9-14, and 18-22 remain for consideration. All claims are allowable over the cited art.

Response to Arguments section of the Office Action

In paragraph 2.a.) of the Response to Arguments section on page 2 of the Office Action, the Examiner violates the anticipation standard as set forth in MPEP § 2131. In particular, rather than showing how Nakayama expressly or inherently teaches each and every element of Applicant's claims, the Examiner instead attempts to show that Nakayama teaches limitations that are purportedly described in Applicant's instant specification. As mandated by MPEP § 2131, however, an anticipation rejection must not be based on the disclosure contained within Applicant's instant specification, but rather must be based upon the claimed elements and their limitations. Thus, Applicant respectfully submits that the Examiner's anticipatory rejections of Applicant's claims, which are based upon improper grounds as presented in the Response to Arguments section of the Office Action, do not conform to a proper showing of anticipation.

In addition, to establish a *prima facie* case of obviousness, a third criteria requires that the prior art reference (or references when combined) teach or suggest all the claim limitations. (See MPEP § 2142). As discussed above, however, the Examiner attempts to show that Nakayama teaches limitations that are purportedly described in Applicant's instant specification, rather than showing how Nakayama teaches or suggests all the claim limitations. Thus, Applicant respectfully submits that the Examiner's obviousness rejections of Applicant's claims, which are based upon improper grounds as presented in the Response to Arguments section of the Office Action, do not properly establish a *prima facie* case of obviousness.

Since the Examiner maintains anticipatory and obviousness rejections of Applicant's claims that are based upon improper grounds of rejection, Applicant respectfully requests that the finality of the rejections be withdrawn. Notwithstanding the impropriety of the finality of the rejections, Applicant nevertheless addresses each rejection individually to further advance prosecution.

35 U.S.C. §102

The Office Action rejects claims 1-3 and 10-12 as being anticipated under 35 U.S.C. §102(b) by U.S. Patent No. 4,686,686 to Nakayama et al (hereinafter "Nakayama"). Applicant respectfully traverses the rejection.

To anticipate a claim, the reference must teach every element of the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). (See MPEP § 2131). Therefore, all claim elements, and their limitations, must be found in the prior art reference to maintain a rejection based on 35 U.S.C. §102. Applicant respectfully submits that Nakayama does not teach every element of claims 1 and 10, and therefore, fails to anticipate claims 1 and 10.

Applicant's claim 1, for example, at least sets forth "an amplifier," e.g., amplifier 250 of FIG. 4, "having ... an input continuously coupled to receive an input signal" and "a feed-forward circuit," e.g., feed-forward circuit 270, "in parallel with the amplifier." The Examiner nevertheless suggests a correspondence between the amplifier of FIG. 14, which is part of feed-forward circuit 270, and the amplifier as recited in Applicant's claim 1. Paragraph [0038] of the instant specification, however, discloses that amplifier 580, capacitor 566, and switch 633, in an exemplary embodiment, corresponds to feed-forward circuit 270. As can further be seen in FIG. 14, feed-forward circuit 270, in an exemplary embodiment, is coupled in parallel with amplifier, e.g., 250, as is required by claim 1. Thus, contrary to the Examiner's suggestion, the amplifier of FIG. 14 cannot correspond to the amplifier as recited in Applicant's claim 1 because the amplifier of FIG. 14 is part of feed-forward circuit 270, which in turn, is coupled in parallel with amplifier 250. Accordingly, the input to the amplifier as recited in Applicant's claim 1 is "continuously coupled to receive an input signal" despite the Examiner's suggestion to the contrary.

The Examiner, therefore, maintains the rejection of Applicant's claim 1 based upon an improper application of the anticipation standard, as discussed above, as well as a misunderstanding of Applicant's instant specification. Thus, Nakayama has not been shown to anticipate Applicant's claim 1. In fact, Nakayama requires that the input to amplifier 30 be non-continuous, so that the input signal can be sampled in a known manner (see FIG. 2 and column 2 line 65 to column 3 line 8), which is in direct contrast to Applicant's claim 1. Since Applicant's claim 10 similarly sets forth a continuous connection to the amplifier's input, Nakayama's teaching is in direct contrast to claim 10 as well. Applicant respectfully submits, therefore, that claims 1 and 10 patentably distinguish over Nakayama and are in condition for allowance.

Dependent claims 2-3 and 11-12, which are dependent from independent claims 1 and 10, respectively, are also rejected under 35 U.S.C. §102(b) as being unpatentable over Nakayama. While Applicant does not acquiesce to the particular rejections to these dependent claims, it is believed that these rejections are now moot in view of the remarks made in connection with independent claims 1 and 10. These dependent claims include all of the limitations of the base claims and any intervening claims, and recite additional features which further distinguish these claims from the cited references. Therefore, dependent claims 2-3 and 11-12 are also in condition for allowance.

35 U.S.C. §103

Claims 4-5 and 13-14 are rejected under 35 USC §103(a) as being made obvious by the teachings of Nakayama in view of U.S. Patent No. 3,886,470 to O'Neil et al (hereinafter "O'Neil"). Applicant respectfully traverses the rejection.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of

success must both be found in the prior art, and not based on applicant's disclosure. (See MPEP § 2142).

Concerning the third criteria which must be met to establish *prima facie* obviousness of a claimed invention, the combination of Nakayama and O'Neil must be shown to teach or suggest all of Applicant's claimed limitations. In regard to Applicant's Claims 1 and 10 as discussed above, however, Nakayama requires the input to amplifier 30 to have a non-continuous connection to its input signal through operation of switch 20 (see FIG. 2 and column 2 line 65 to column 3 line 8), which is in direct contrast to Applicant's claims 1 and 10.

Combining Nakayama with O'Neil in order to remedy such a deficiency also fails with respect to the first criteria, which must be met to establish *prima facie* obviousness of a claimed invention. "If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious." (See MPEP § 2143.01 VI). Assuming *arguendo* that the Office Action were to suggest that Nakayama's alternating connection to amplifier 30, as facilitated by switch 20, were to be modified with the continuous input connection to the amplifier of O'Neil, then it would impermissibly change the operation of Nakayama. In particular, Nakayama teaches that "switches 16-21 serve to sample the input signal IN in a known manner." (See column 3, lines 6-8). Thus, modifying Nakayama with O'Neil would prohibit Nakayama from sampling the input signal in a known manner in violation of MPEP § 2143.01 VI.

Since the combination of Nakayama and O'Neil fails to establish a *prima facie* case of obviousness with respect to Applicant's claims 1 and 10, it follows that the combination of Nakayama and O'Neil similarly fails with respect to the dependent claims of claims 1 and 10. In particular, dependent claims 4-5 and 13-14 include all of the limitations of claims 1 and 10, respectively, and recite additional features which further distinguish these claims from the combination of Nakayama and O'Neil. Applicant respectfully submits, therefore, that claims 4-5 and 13-14 patentably distinguish over the combination of Nakayama and O'Neil and are in condition for allowance.

Claim 9 is rejected under 35 USC §103(a) as being made obvious by the teachings of Nakayama in view of U.S. Patent No. 5,493,246 to Anderson. Applicant respectfully traverses the rejection.

Concerning the third criteria which must be met to establish *prima facie* obviousness of a claimed invention, the combination of Nakayama with Anderson must be shown to teach or suggest all of Applicant's claimed limitations. In regard to Applicant's claim 1 as discussed above, however, Nakayama requires the input to amplifier 30 to have a non-continuous connection to its input signal through operation of switch 20 (see FIG. 2 and column 2 line 65 to column 3 line 8), which is in direct contrast to Applicant's claim 1.

Thus, combining Nakayama with Anderson, or any other reference that teaches a continuous connection to the input of an amplifier, to obtain a correspondence to Applicant's claim 1 is violative of the first and third criterion for establishing *prima facie* obviousness of Applicant's claim 1. It further follows that the combination of Nakayama and Anderson fails with respect to dependent claim 9, which includes all of the limitations of claim 1 and recites additional features which further distinguish this claim from the combination of Nakayama with Anderson. Applicant respectfully submits, therefore, that claim 9 patentably distinguishes over the combination of Nakayama with Anderson and is in condition for allowance.

Claims 18-20 are rejected under 35 USC §103(a) as being made obvious by the teachings of Nakayama in view of U.S. Patent No. 3,939,437 to Adam. Applicant respectfully traverses the rejection.

Concerning the third criteria which must be met to establish *prima facie* obviousness of a claimed invention, the combination of Nakayama with Adam must be shown to teach or suggest all of Applicant's claimed limitations. In particular, Applicant's claim 18 at least sets forth that "the input of the amplifier is continuously coupled to an output of the second device" as is similarly set forth in Applicant's claims 1 and 10 as discussed above. However, Nakayama requires the input to amplifier 30 to have a non-continuous connection to its input signal through operation of switch 20

(see FIG. 2 and column 2 line 65 to column 3 line 8), which is in direct contrast to Applicant's claim 18.

Thus, combining Nakayama with Adam, or any other reference that teaches a continuous connection to the input of an amplifier, to obtain a correspondence to Applicant's claim 18 is violative of the first and third criterion for establishing *prima facie* obviousness of Applicant's claim 18. It further follows that the combination of Nakayama and Adam fails with respect to dependent claims 19-20, which include all of the limitations of claim 18 and recite additional features which further distinguish these claims from the combination of Nakayama with Adam. Applicant respectfully submits, therefore, that claims 18-20 patentably distinguish over the combination of Nakayama and Adam and are in condition for allowance.

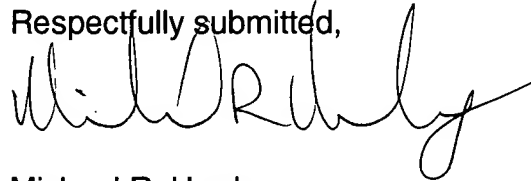
Claims 21-22 are rejected under 35 USC §103(a) as being made obvious by the teachings of Nakayama in view of Adam and further in view of O'Neil. Applicant respectfully traverses the rejection.

As discussed above, combining the teachings of Nakayama with Adam and O'Neil, or any other reference that teaches a continuous connection to the input of an amplifier, to obtain a correspondence to Applicant's claim 18 is violative of the first and third criterion for establishing *prima facie* obviousness of Applicant's claim 18. It further follows that the combination of Nakayama with Adam and O'Neil fails with respect to dependent claims 21-22, which include all of the limitations of claim 18 and recite additional features which further distinguish these claims from the combination of Nakayama with Adam and O'Neil. Applicant respectfully submits, therefore, that claims 21-22 patentably distinguish over the combination of Nakayama with Adam and O'Neil and are in condition for allowance.

CONCLUSION

Reconsideration and a notice of allowance are respectfully requested in view of the remarks presented above. If the Examiner has any questions or concerns, a telephone call to the undersigned is invited.

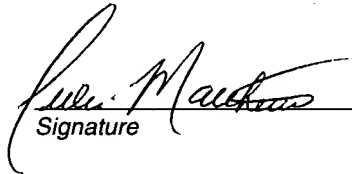
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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, on July 26, 2007.

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Name


Signature